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LUEDEKA, NEELY & GRAHAM, P.C.
P O BOX 1871
KNOXVILLE, TN 37901

EXAMINER

NINO, ADOLFO

ART UNIT PAPER NUMBER

2831

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,114

Applicant(s)

BURDICK, BRETT R.

Examiner

Adolfo Nino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of: _____
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/7/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Drawings

The drawings are objected to because in Fig. 1D, the lead line for reference "44a" is missing. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 23-25 are objected to because of the following informalities:

Claims 23-25 are objected to under 37 CFR 1.75(c) as being in improper form because multiple dependent claims 23-25 should refer to other claims in the alternative

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only. See MPEP § 608.01(n). Accordingly, the claims 23-25 have not been further treated on the merits.

Claim 23 is dependent of itself. **Note:** the Examiner interpreted claims **23-25** as being dependent of claim 22, for the Examiner believes it was a typographical error.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19, lines 1-2, "or other locations" is indefinitely. What other locations?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Ruth et al. (US 4,695,677). Ruth et al. disclose a fence system, comprising a current carrying wire (col. 4, lines 11-13) connectable to a source of electric current (col. 4, lines 16-18), a ground wire (col. 4, line 14), and a unitary insulator (figs. 1-15) configured to receive the

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current carrying wire and the ground wire and to maintain the wires in a spaced apart and electrically isolated orientation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lance (GB 2, 187,771).

Regarding claim 1, Lance discloses a fence insulator (figs. 1-15), the insulator (figs. 1-15) comprising a body of molded plastic construction (pg. 1, lines 96-100) mountable to a support (31 in figs. 9-10) and including a pair of spaced apart sidewalls (not marked, but it would be the sidewalls shown in fig. 10 between references 4 and 35) connected by a connecting wall (not marked, but it would be the wall section where reference 35 is connected); a first pair of aligned grooves (11 seen in fig. 4) defined across a first portion of the connecting wall (figs. 1, 10); a first retention member (35 in fig. 10) positioned adjacent the first pair of aligned grooves and configured for receiving one of the wires underneath a portion thereof (fig. 10); **but Lance does not disclose** a second pair of aligned grooves defined across a second portion of the connecting wall spaced apart from and substantially parallel to the first pair of aligned grooves; and a second retention member positioned adjacent the second pair of aligned grooves and

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configured for receiving one of the wires underneath a portion thereof, wherein one of the wires is positionable underneath the first retention member and within the first pair of aligned grooves and the other one of the wires is positionable underneath the second retention member and within the second pair of aligned grooves for maintaining the pair of fence wires in a desired common plane and spaced a desired distance apart. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a second pair of aligned grooves defined across a second portion of the connecting wall spaced apart from and substantially parallel to the first pair of aligned grooves; and a second retention member positioned adjacent the second pair of aligned grooves and configured for receiving one of the wires underneath a portion thereof, wherein one of the wires is positionable underneath the first retention member and within the first pair of aligned grooves and the other one of the wires is positionable underneath the second retention member and within the second pair of aligned grooves, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 2, Lance discloses the fence insulator of claim 1, wherein the first retention member (35 in fig. 10) comprises a pair of oppositely disposed fingers (35 in fig. 10) located adjacent the first portion of the connecting wall and spaced interior the

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first pair of grooves (fig. 10), and the second retention member comprises a pair of oppositely disposed fingers located adjacent the second portion of the connecting wall and spaced interior the second pair of grooves.

Regarding claim 3, Lance discloses the fence insulator of claim 1, wherein the first retention member (35 in fig. 10) comprises a first flexible tab (35 in fig. 10) defined adjacent the first portion of the connecting wall with an underlying cutout (not marked, but the cutout could be seen in fig. 9 next to lower reference 5) defined within the first portion of the connecting wall (figs. 9-10), and the second retention member comprises a second flexible tab defined adjacent the second portion of the connecting wall with an underlying cutout defined within the second portion of the connecting wall, wherein the first and second flexible tabs open in opposite directions toward a middle portion of the connecting wall (once retention member 35 is duplicated, the tabs 35 would open in opposite directions since in fig. 10 tabs 35 open in opposite directions).

Regarding claim 4, Lance discloses the fence insulator of claim 1, further comprising arms (23 in fig. 11) extending from edges of the body (fig. 11), the arms spaced apart (fig. 11) and configured to snap fit around a post. **Note** that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 5, Lance discloses the fence insulator of claim 1, further comprising mounting members (4 in fig. 10) comprising substantially planar portions (4)

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extending from opposite locations of the body in substantially opposite directions for mounting the insulator to a support surface (fig. 9).

Regarding claim 6, Lance discloses the fence insulator of claim 5, wherein the mounting members (4) extend from opposite sides of the body (fig. 10).

Regarding claim 7, Lance discloses the fence insulator of claim 5, wherein the mounting members (4) extend from opposite ends of the body (fig. 9).

Regarding claim 8, Lance discloses the fence insulator of claim 1, further comprising one or more discontinuities (not marked, but it would be opposite to reference 38 as seen in figs. 2, 10, 11) defined on the body for reducing the likelihood of electrical communication between the wires when they are installed on the insulator.

Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Regarding claim 9, Lance discloses a fence insulator (figs. 1-15), the insulator comprising an elongate body of molded plastic construction (pg. 1, lines 96-100) mountable to a support (31) and including a wire mounting face (2 in fig. 10); a first

retention member (35 in fig. 10) positioned adjacent the wire mounting face and configured for receiving one of the wires underneath a portion thereof; **but Lance does not disclose** a second retention member configured for receiving the other one of the wires underneath a portion thereof and located adjacent the wire mounting face and longitudinally spaced apart from the first retention member for maintaining a pair of

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fence wires in a desired common plane and spaced a desired distance apart. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a second retention member configured for receiving the other one of the wires underneath a portion thereof and located adjacent the wire mounting face and longitudinally spaced apart from the first retention member for maintaining the pair of fence wires in a desired common plane and spaced a desired distance apart, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. **Note** that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 10, Lance discloses the fence insulator of claim 9, wherein the first retention member (35) comprises a first rigid tab (35) with an underlying first cutout (the cutout not marked, but clearly seen in fig. 9 next to reference 5, it would be the cutout facing reference 35) defined within a first portion of the wire mounting face, and the second retention member comprises a second rigid tab with an underlying second cutout defined within a second portion of the wire mounting face, wherein the first and second rigid tabs open in the same direction toward an end of the insulator (once retention member 35 is duplicated, tabs 35 in the same side would open in the same direction).

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Regarding claim 11, Lance discloses the insulator of claim 10, wherein the first rigid tab (35) includes a projection (not marked, but it would be the projection of reference 35 as seen in fig. 9) on a surface thereof facing the first cutout (fig. 9), and the second rigid tab includes a projection on a surface thereof facing the second cutout (duplication of parts).

Regarding claim 12, Lance discloses the fence insulator of claim 9, wherein the first retention member (35) comprises a pair of oppositely disposed fingers (fig. 10), and the second retention member comprises a pair of oppositely disposed fingers (duplication of parts).

Regarding claim 13, Lance discloses the fence insulator of claim 9, wherein the first retention member (35) comprises a first flexible tab (35), and the second retention member comprises a second flexible tab (duplication of parts), wherein the first and second flexible tabs open in opposite directions toward a middle portion of the mounting face (once retention member 35 is duplicated, opposite sided tabs 35 would open in opposite direction toward a middle portion of the mounting face).

Regarding claim 14, Lance discloses the fence insulator of claim 9, further comprising arms (23 in fig. 11) extending from edges of the body, the arms spaced apart (fig. 10) and configured to snap fit around a post. **Note** that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

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Regarding claim 15, Lance discloses the fence insulator of claim 9, further comprising mounting members (4) comprising substantially planar portions extending from opposite locations of the body in substantially opposite directions (fig. 10) for mounting the insulator to a support surface. **Note** that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Regarding claim 16, Lance discloses the fence insulator of claim 15, wherein the mounting members (4) extend from opposite sides of the body (fig. 10).

Regarding claim 17, Lance discloses the fence insulator of claim 15, wherein the mounting members (4) extend from opposite ends of the body (fig. 9).

Regarding claim 18, Lance discloses the fence insulator of claim 9, further comprising one or more discontinuities (not marked, but it would be opposite to reference 38 as seen in figs. 2, 10, 11) defined on the body for reducing the likelihood of electrical communication between the wires when they are installed on the insulator.

Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

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Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (US 4,263,477).

Regarding claim 19, Wilson discloses a fence insulator (10) for installation at corners of a fence or other locations where first and second spaced apart fence wires undergo an abrupt change of direction (col. 1, lines 6-8), the insulator comprising (10) an elongate body (12) of molded plastic construction (col. 2, lines 3-5) mountable to a support (24) and including a wire mounting face (14); a first rigid tab (46) positioned adjacent the wire mounting face and having an opening for passage of the first wire and a curved closed end (38) configured for bearing against the first wire to provide a radius for the first wire to curve around to reduce stresses on the first wire as it undergoes a relatively abrupt change of direction (figs. 1-3); **but Wilson does not disclose a second rigid tab positioned adjacent the wire mounting face longitudinally spaced apart from the first tab and having an opening for passage of the second wire and a curved closed end configured for bearing against the second wire to provide a radius for the second wire to curve around to reduce stresses on the second wire as it undergoes a relatively abrupt change of direction.** It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a second rigid tab positioned adjacent the wire mounting face longitudinally spaced apart from the first tab and having an opening for passage of the second wire and a curved closed end configured for bearing against the second wire to provide a radius for the second wire to curve around to reduce stresses on the second wire as it undergoes a relatively abrupt change of direction, since it has been held that mere duplication of the essential working parts of a

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device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193

USPQ 8. **Note** that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 20, Wilson discloses the fence insulator (10) of claim 19, wherein the first rigid tab (46) includes a projection on a surface thereof facing the wire mounting surface (fig. 2), and the second rigid tab includes a projection on a surface thereof facing the wire mounting surface (duplication of parts).

Regarding claim 21, Wilson discloses the fence insulator (10) of claim 19, further comprising one or more discontinuities (16) defined on the body for reducing the likelihood of electrical communication between the wires when they are installed on the insulator. **Note** that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruth et al. (US 4,695,677) in view of Lance (GB 2,187,771 A).

Regarding claim 23, Ruth et al. disclose the insulator fence system of claim [23] 22 (presumed as being dependent of claim 22 instead of claim 23), **except for** wherein

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the insulator comprises the insulator of claim 1. Lance discloses that it is known in the art to provide an insulator as claimed in claim 1 above. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the insulator of Ruth et al. with the insulator of Lance, in order to provide a versatile insulator. See *In re Preda* 159 USPQ 342 (CCPA, 1968).

Regarding claim 24, Ruth et al. disclose the fence system of claim [23] 22 (presumed as being dependent of claim 22 instead of claim 23), **except for** wherein the insulator comprises the insulator of claim 9. Lance discloses that it is known in the art to provide an insulator as claimed in claim 9 above. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the insulator of Ruth et al. with the insulator of Lance, in order to provide a versatile insulator. See *In re Preda* 159 USPQ 342 (CCPA, 1968).

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ruth et al. (US 4,695,677) in view of Wilson (US 4,263,477). Ruth et al. disclose the insulator fence system of claim [23] 22 (presumed as being dependent of claim 22 instead of claim 23), **except for** wherein the insulator comprises the insulator of claim 19. Wilson discloses that it is known in the art to provide an insulator as claimed in claim 19 above. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the insulator of Ruth et al. with the insulator of

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Wilson, in order to provide a versatile insulator. See *In re Preda* 159 USPQ 342 (CCPA, 1968).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thomson (US 6,489,569 B1) discloses an insulator retainer. Berg et al. (US 5,975,501) disclose a fence strand retainer clip. Teixeira (US 5,085,409) discloses a wire holding cap. Johnson (US 5,063,274) discloses an electric fence insulator. Maranell (US 4,049,905) discloses an insulator. Wilson (US 3,652,780) discloses an insulator.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adolfo Nino whose telephone number is (571) 272-1981. The examiner can normally be reached on M-F (7:30-5:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A Reichard can be reached on (571) 272-2800 ext. 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

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<http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AN


DEAN A. REICHARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800